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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,459	07/21/2003	Christopher J. Skinner	21128.01	5227
37833 7590 08/09/2007 LITMAN LAW OFFICES, LTD. P.O. BOX 15035 CRYSTAL CITY STATION ARLINGTON, VA 22215			EXAMINER FRENEL, VANEL	
			ART UNIT 3627	PAPER NUMBER
			MAIL DATE 08/09/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/622,459

Applicant(s)

SKINNER, CHRISTOPHER J.

Examiner

Vanel Frenel

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07212003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the application filed on 7/21/03. Claims 1-13 are pending.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-13 of US Application No.10/622,459 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4, 5-7, 9 and 13 of copending Application No. 10/307,314 as originally filed. Although the conflicting claims are not identical, they are not patentably distinct from each other because it is well settled that adding or deleting of an element and its

Art Unit: 3627

function in claim 1 (such as "and bid management in order to cover advertising costs", "said data including at least the number of resulting sales generated by said at least one search term at a given time period", "said master data set further including at least the number of resulting sales at various time periods", "said specified conditions including at least the time period of any sale of a service or product and the amount of such sale", "said new maximum bid including at least the factors of amount of sales and costs to advertise", "wherein said profit determining factors comprise an expected return on advertising spent (ROAS) value, a minimum acceptable return on advertising spent (ROAS) value, a maximum return on advertising spent (ROAS) value, a computational linguistics value of the search term, and the new maximum acceptable bid value", "said insertion order including at least the determination that the bid is a predetermined minimal value above the highest competitor bid which falls below the new maximum acceptable bid value" and "the" is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA 1963). In addition, claims 11 and 16 are not patentably distinct of US Application No. 10/622,459 because it would have been obvious to one of ordinary skill in the art to use "bids and bid management in order to cover advertising costs, said system", "said user activity including at least the number of resulting sales generated by said at least one search term at a given time period", "periods", "said master data set further including at least the number of resulting sales at various time periods", "said specified conditions including at least the time period of any sale of a service or product and the amount of such sale", "said new maximum bid including at least the factors of amount of sales and

Art Unit: 3627

costs to advertise”, “wherein said profit determining factors comprise an expected return on advertising spent (ROAS) value, a minimum acceptable return on advertising spent (ROAS) value, a maximum return on advertising spent (ROAS) value, a computational linguistics value of the search term, and the new maximum acceptable bid value”, “eighth”, “said insertion order including at least the determination that the bid is a predetermined minimal value above the highest competitor bid which falls below the new maximum acceptable bid value” and “the” in order to allow a subscriber advertiser to automatically and continually monitor and change bids in its pay-per-click search engine account based upon preset parameters established by the subscriber advertiser, with such parameters including maximum bid amount, dynamic bid schedule, as well as competitor behavior.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not been patented.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be

Art Unit: 3627

negated by the manner in which the invention was made.

5. Claims 1-9, 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheung et al (2003/0028529) in view of Soulanille (2001/0051940).

(A) As per claim 1, Cheung discloses an automated method for web ranking of bids, comprising the steps of:

tracking Internet user activity generated to an OMM and an advertiser's website when an Internet user conducting a web-based search on the OMM enters at least one search term relating to a service or product of the advertiser (See Cheung, Page 1, Paragraphs 0005-0009);

acquiring data relating to the Internet user activity (See Cheung, Page 4, Paragraph 0047);

sorting said data to remove duplicate information (See Cheung, Page 4, Paragraph 0050);

compiling a master data set from said data wherein data values are arranged according to time of Internet user activity and a designated primary key (See Cheung, Page 4, Paragraph 0049);

determining sufficiency of data based on specified conditions (See Cheung, Page 6, Paragraph 0070);

calculating an acceptable new maximum bid for said search term (See Cheung, Page 10, Paragraph 0117); determining whether said maximum bid is a justified expense for the advertiser in light of profit determining factors (See Cheung, Page 11, Paragraphs 0126-0127);

determining whether to maintain, modify, or remove a bid for a search term (See Cheung, Page 10, Paragraph 0122);

retrieving information on competitor's bids (See Cheung, Page 10, Paragraphs 0116-0117);

identifying desired ranking (See Cheung, Page 13, Paragraph 01400);

preparing an insertion order with an appropriate bid for achieving the desired ranking (See Cheung, Page 10, Paragraphs 0116-0117).

Cheung does not explicitly disclose that the method having automatically uploading insertion order to OMM.

However, this feature is known in the art, as evidenced by Soulanille. In particular, Soulanille suggests that the method having automatically uploading insertion order to OMM (See Soulanille, Page 2, Paragraph 0014).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have include the feature of Soulanille within the system of Cheung with the motivation of providing a database of search listings in which each search listing is associated with an advertiser and includes at least one search term and a bid amount by the advertiser (See Soulanille, Page 1, Paragraph 0016).

(B) As per claim 2, Cheung discloses the method wherein Internet user activity generated to an OMM and an advertiser's website is tracked by the OMM, the advertiser's website, and a tracking engine (See Cheung, Page 2, Paragraph 0013).

Art Unit: 3627

(C) As per claim 3, Soulanille discloses the method wherein said tracking engine tracks the Internet user's activity by assigning a tracking URL having a keycode embedded therein that identifies the OMM and a search term which was used by the Internet user to access the advertiser's listing (See Soulanille, Page 4, Paragraphs 0038-0040).

The motivation for combining the respective teachings of Cheung and Soulanille are as discussed in the rejection of claim 1 above, and incorporated herein.

(D) As per claim 4, Soulanille discloses the method wherein said primary key comprises the keycode used in the tracking URL (See Soulanille, Page 4, Paragraph 0038).

The motivation for combining the respective teachings of Cheung and Soulanille are as discussed in the rejection of claim 1 above, and incorporated herein.

(E) As per claim 5, Soulanille discloses the method further comprising the steps of:
providing the advertiser's web site with content management system software displaying a plurality of web pages containing unique advertisements, each advertisement having a unique telephone number published therein (See Soulanille, Page 3, Paragraphs 0036-0037);

assigning a keycode to each telephone call received at the telephone numbers published in the advertisements, the keycode identifying the telephone number associated with the advertisement (See Soulanille, Page 3, Paragraphs 0036-0037);

recording data regarding receipt of each telephone call and purchase orders is resulting therefrom in said master data set (See Soulanille, Page 6, Paragraphs 0053-0054; Page 8, Paragraphs 0070-0072).

The motivation for combining the respective teachings of Cheung and Soulanille are as discussed in the rejection of claim 1 above, and incorporated herein.

(F) As per claim 6, Cheung discloses the method wherein said recording step is performed automatically by call center software (See Cheung, Page 1, Paragraph 0006).

(G) As per claim 7, Soulanille discloses the method wherein said step of acquiring data relating to Internet user activity includes sending GET requests at specified time intervals to the OMM, the tracking engine, and the advertiser's web site (See Soulanille, Page 10, Paragraphs 0092-0093).

The motivation for combining the respective teachings of Cheung and Soulanille are as discussed in the rejection of claim 1 above, and incorporated herein.

(H) As per claim 8, Soulanille discloses the method further comprising maintaining a database of a plurality of search terms relating to the advertiser's service or product (See Soulanille, Page 6, Paragraphs 0052-0054).

The motivation for combining the respective teachings of Cheung and Soulanille are as discussed in the rejection of claim 1 above, and incorporated herein.

(I) As per claim 9, Soulanille discloses the method wherein the data set contains a designated threshold value of visits and actions taken by the user on the advertiser's website for fulfilling said specified conditions for data sufficiency (See Soulanille, Page 9, Paragraph 0081).

The motivation for combining the respective teachings of Cheung and Soulanille are as discussed in the rejection of claim 1 above, and incorporated herein.

(J) As per claim 11, Soulanille discloses the method wherein said step of identifying desired ranking includes identifying the highest competitor bid which falls below the new maximum acceptable bid value (See Soulanille, Page 6, Paragraphs 0057-0060; Page 9, Paragraph 0081).

The motivation for combining the respective teachings of Cheung and Soulanille are as discussed in the rejection of claim 1 above, and incorporated herein.

(K) As per claim 13, Cheung discloses a computerized method form managing online banner advertising, comprising the steps of:

tracking Internet user activity generated to an OMM and an advertiser's website when an Internet user clicks on a banner advertisement published on an Online Marketing Media (OMM) web site (See Cheung, Page 1, Paragraphs 0005-0009);

Art Unit: 3627

means for acquiring data relating to the Internet user activity (See Cheung, Page 4, Paragraph 0047; Page 9, Paragraph 0109);

acquiring data relating to the Internet user activity (See Cheung, Page 9, Paragraph 0109);

sorting said data to remove duplicate information (See Cheung, Page 4, Paragraph 0050);

compiling a master data set from said data wherein data values are arranged according to time of Internet user activity and a designated primary key (See Cheung, Page 9, Paragraphs 0108-0109);

determining sufficiency of data based on specified conditions (See Cheung, Page 6, Paragraph 0070).

Cheung does not explicitly disclose that the method having computing a return on advertising spent for the published advertisement; comparing the return on advertising spent to a predetermined limit; and automatically sending a notice of cancellation of the advertisement to the OMM when the return on advertising spent is less than the predetermined limit.

However, these features are known in the art, as evidenced by Soulanille. In particular, Soulanille suggests that the method having computing a return on advertising spent for the published advertisement (See Soulanille, Page 2, Paragraph 0012); comparing the return on advertising spent to a predetermined limit (See Soulanille, Page 9, Paragraphs 0084-0085); and automatically sending a notice of cancellation of

Art Unit: 3627

the advertisement to the OMM when the return on advertising spent is less than the predetermined limit (See Soulanille, Page 7, Paragraphs 0065-0066).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have include the feature of Soulanille within the system of Cheung with the motivation of providing a database of search listings in which each search listing is associated with an advertiser and includes at least one search term and a bid amount by the advertiser (See Soulanille, Page 1, Paragraph 0016).

Allowable Subject Matter

6. Claims 10 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not the applied art teaches system for providing business information (2002/0147708), system and method for providing integrated inventory control of time-sensitive inventory (2002/0072999) and internet marketing method and system (6,477,509).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 571-272-6769. The examiner can normally be reached on 6:30am-5:00pm.

Art Unit: 3627

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zeender Ryan Florian can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Vanel Frenel
Art Unit 3627
July 30, 2007